



04 AUG 2006

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In re Application of	:	
TRIFONI, et al.	:	DECISION ON PETITION
Serial No.: 10/550,123	:	
PCT No.: PCT/EP04/03424	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 31 March 2004	:	
Priority Date: 01 April 2003	:	
Atty Docket No.: 267.193	:	
For: METHOD FOR OPERATING A	:	
MEMBRANE ELECTROCHEMICAL	:	
GENERATOR	:	

This decision is in response to applicant's "PETITION UNDER RULE 47(a)" filed 22 March 2006 to accept the application without the signatures of joint inventors, Eduardo Trifoni and Matteo Lenardon.

BACKGROUND

On 31 March 2004, applicant filed international application PCT/EP04/03424 which claimed priority to a previous application filed 01 April 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 01 October 2003.

On 19 September 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1). In addition, applicant filed combined declaration and power of attorney executed by seven of the nine inventors listed on the published international application.

On 22 March 2006, applicant filed the present petition under 37 CFR 1.47(a) to accept the application without the signatures of joint inventors Eduardo Trifoni and Matteo Lenardon.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding item (1), applicant has only provided payment of \$130.00 for the petition fee. Applicants are advised that pursuant to 37 CFR 1.17(g), the petition fee is \$200.00 and is required. Item (1) is not yet satisfied.

Regarding item (2) above, petitioner states that Eduardo Trifoni and Matteo Lenardon have refused to sign the application. Section 409.03(d) of the MPEP, **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition reveals that applicant has not satisfied item (2) above, in that the applicant has not shown that a *bona fide* attempt was made to present the application papers, including the specification, claims, drawings, and oath/declaration to Eduardo Trifoni and Matteo Lenardon. The declaration of Annie Tuosto states that she mailed a copy of the application, declaration and an assignment document to Mr. Lenardon on 21 December 2005 and sent an email to Mr. Trifoni. However, applicant has not presented sufficient evidence to show that Messrs. Lenardon and Trifoni were presented with and received a complete copy of the application papers including a declaration and that they refuse to sign the application papers.

As detailed above, the inventors must be presented with a complete copy of the application papers including an oath or declaration for execution. As to Mr. Lenardon, his silence cannot be constituted as a refusal in the immediate circumstances as it is unclear whether he received the papers and whether they did in fact contain an oath or declaration for execution. Ms. Tuosto's letter did not identify the application number and what

enclosures were sent to Mr. Lenardon. Furthermore, the postal receipt was not translated into English and it is unclear that Mr. Lenardon actually received the papers.

With regard to Mr. Trifoni, a copy of the email sent to him by Ms. Tuosto was not provided, nor was his emailed reply. In cases where it is argued that the non-action of an inventor should be considered a refusal to cooperate it is especially important to provide proof of delivery of the papers, as well as, a firsthand statement of the preparation and mailing of the papers.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, drawings and oath/declaration) were sent to Eduardo Trifoni and Matteo Lenardon, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration. All documentary evidence should be translated into English.

The last known addresses of the nonsigning inventors were not provided and are required. Thus, Item (3) is not satisfied.

The declarations executed by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor is acceptable and satisfies Item (4) above.

In light of the above, Items (1), (2) and (3) above are not yet satisfied and thus, it is inappropriate to grant applicant's petition under 37 CFR 1.47(a) at this time.

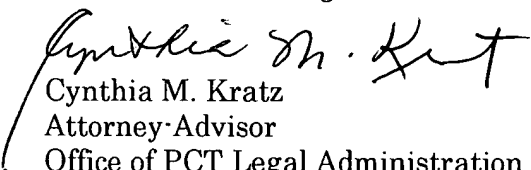
CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Applicant is advised that in order for the renewed petition to be considered, applicant must provide payment of the remaining \$70.00.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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Application No.: 10/550,123

4

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